

interactive wagering application implemented using the user equipment, comprising:

allowing the user to create and place a wager for a given race by interacting with a plurality of wager creation options;

automatically prompting the user to decide whether to record the given race while the user is interacting with the plurality of wager creation options; and

recording the given race.

#### REMARKS

##### I. Introduction

Claims 1-56 were pending. Claim 1 has been amended. (These remarks are followed by an Appendix showing how claim 1 has been amended). No new matter is being added.

The Examiner objected to claim 16 under 37 C.F.R. § 1.75(c) as being of improper dependant form. Claim 17 was rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in a way as to enable one skilled in the art to make and/or use the invention. Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-56 were rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over Brenner et al., U.S. Patent No. 5,830,068 (hereinafter "Brenner"), in view of Faust et al., U.S. Patent No. 5,752,159 (hereinafter "Faust"). Claims 1-56 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Wilson et al., U.S. Patent No. 5,411,258 (hereinafter "Wilson"), in view of Faust.

The Examiner's objection and rejections are respectfully traversed.

## II. Applicants' Amendment

Applicants have amended claim 1, adding "race" after the words "the given" on line 9 of the claim. The word "race" was inadvertently omitted from the claim and this amendment, therefore, corrects a typographical error. Applicants submit that this amendment is not a "substantial amendment related to patentability" within the meaning of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000), but instead relates merely to a matter of form.

## III. Reply to Claim Rejection Under 37 C.F.R. § 1.75(c)

The Examiner objected to claim 16 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Examiner contends that claim 16 describes recording a live event in real time and, because doing otherwise would be impossible due to the immutable rate of time, the claim fails to further limit the parent claim. Applicants respectfully disagree with the Examiner's contentions.

Applicants' specification discloses that races may be provided to user equipment in real-time or may be recorded and provided to user equipment at a later time (see, for example, page 29, lines 21-30 of applicants' specification). Therefore, a race may be recorded in real-

time or at a later time (see page 44, lines 4-15 of applicants' specification). Accordingly, claim 16 further limits claim 1 by specifying that the race is recorded in real-time rather than at a later time. Applicants respectfully submit that claim 16 is in accordance with 37 C.F.R. § 1.75(c) and request that the Examiner's objection be withdrawn.

**IV. Reply to Claim Rejections  
Under 35 U.S.C. § 112**

The Examiner rejected claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants have amended claim 1 to correct a typographical error as discussed above. Accordingly, applicants respectfully submit that claim 1, as amended, is in accordance with 35 U.S.C. § 112 and request that the Examiner's rejection be withdrawn.

The Examiner rejected claim 17 under 35 U.S.C. § 112, second paragraph, for containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. Specifically, the Examiner contends that claim 17 describes recording a live event after it has taken place. The Examiner further contends that due to the immutable progression of time, it is impossible to record an event that occurred in the past. Applicants respectfully disagree with the Examiner's contentions.

The method of claim 17 is directed to recording a race after the race has taken place. This is possible

because, as stated above, applicants' specification discloses that races may be provided to user equipment in real-time or may be recorded and provide to user equipment at a later time (see page 29, lines 21-30 of applicants' specification). Accordingly, applicants respectfully submit that claim 17 is in accordance with 35 U.S.C. § 112 and request that the Examiner's rejection be withdrawn.

V. Reply to Claim Rejections  
Under Double Patenting

The Examiner rejected claims 1-56 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-132 of Brenner in view Faust. The Examiner's rejections are respectfully traversed.

1. Claims 1-18 and 37-47

Applicant's invention, as defined by independent claims 1 and 37, is directed to a method and system for wagering on and recording races using an interactive wagering application. A user of the wagering application is allowed to create and place a wager for a given race by interacting with a plurality of wager creation options. While the user interacts with the wager creation options, the interactive wagering application automatically provides the user with an option to record the given race.

Brenner's claims are directed to systems and methods for interactive off-track wagering. Claim 79 of Brenner describes means for presenting options to a user for selecting a desired racetrack, race, wager amount, wager type, and runners. Claim 94 of Brenner describes a user terminal as comprising a video recorder and means for

setting the video recorder to record a predetermined racing video.

Faust discloses a method for automatically collecting and delivering multimedia application event data in an interactive network.

While claims 1-56 of the present application were rejected as being unpatentable over claims 1-132 of Brenner in view of Faust, the Examiner asserts that Brenner describes all of the features of applicants' claims 1 and 37 (see page 3, line 22 to page 4 line 6 of the Office Action). Contrary to the Examiner's assertion, the claims of Brenner fail to disclose or suggest automatically providing the user with an option to record a given race while the user is interacting with a plurality of wager creation options as specified by applicants' independent claims 1 and 37.

As discussed above, the claims of Brenner disclose automatically presenting wager creation options to a user. However, the claims of Brenner fail to disclose or suggest automatically presenting a user with an option to record a race while the user is interacting with the wager creation options as defined in applicants' claims 1 and 37. Moreover, Faust fails to disclose or suggest interactive wagering and fails to disclose or suggest providing a user with an option to record any video.

Accordingly, for at least these reasons, independent claims 1 and 37, and dependant claims 2-18 and 38-47, are allowable over claims 1-132 of Brenner in view of Faust.

2. Claims 19 and 48

Applicant's invention, as defined by independent claims 19 and 48, is directed to a method and system for wagering on and recording races using an interactive wagering application. A user of the wagering application is allowed to create and place a wager for a given race. In response to the user placing the wager for the given race, the user is automatically provided with an opportunity to record the given race.

While claims 1-56 of the present application were rejected as being unpatentable over claims 1-132 of Brenner in view of Faust, the Examiner asserts that Brenner describes all of the features of applicants' claims 19 and 48. Contrary to the Examiner's assertion, however, the claims of Brenner fail to disclose or suggest automatically providing the user with an opportunity to record a given race in response to the user placing a wager for the given race as specified by applicants' claims 19 and 48. Moreover, Faust fails to disclose or suggest interactive wagering and fails to disclose or suggest providing a user with an opportunity to record any video.

Accordingly, for at least these reasons, claims 19 and 48 are allowable over claims 1-132 of Brenner in view of Faust.

3. Claims 20-36 and 49-56

Applicant's invention, as defined by independent claims 20 and 49, is directed to a method and system for searching for races in a racing video archive remote from user equipment using an interactive wagering application. The user is provided with an opportunity to search for racing videos in the racing video archive. The results of

the search are displayed to the user and the user is allowed to select a racing video from the search results for viewing.

Brenner's claims define a source of real-time racing videos of at least one live event (see, for example, claim 69 of Brenner). The racing videos can be displayed on a monitor associated with the user equipment.

Faust discloses an Information Services Infrastructure (ISIS) that allows for developing and executing interactive multi-media applications for delivery on a variety of consumer electronic devices. ISIS includes an Asset Management and Production System (AMPS) that provides multimedia title developers with an easy and convenient way to catalog assets, perform key word searches on assets, archive assets and publish applications (see, for example, column 4, lines 57-64 of Faust).

The Examiner asserts that the claimed invention modifies Brenner by providing digital storage of racing videos. Applicants submit, however, that the racing video archive of claims 20 and 49 can store videos in analogue and digital format (see, for example, page 3, lines 8-11 of applicants' specification). In addition, there is no limitation in claims 20 and 49 limiting the racing video archive to a digital archive.

The Examiner asserts that the combination of the claims of Brenner and Faust results in applicants' claimed invention. This is no so. The claims of Brenner fail to describe any type of racing video archive. Rather, the claims of Brenner describe a source of real-time racing videos. The claims of Brenner, therefore, fail to disclose or suggest using an interactive wagering application to provide the user with an opportunity to search for racing

videos in the racing video archive, displaying the results of the search for the user, and allowing the user to select a racing video for a given race from the search results for viewing as required by claims 20 and 49 of applicants' invention.

Faust allows a developer using AMPS to catalogue assets, perform keyword searches on assets, archive assets, and publish applications. However, Faust fails to disclose or suggest using an interactive wagering application to provide the user with an opportunity to search for racing videos in the racing video archive, displaying the results of the search for the user, and allowing the user to select a racing video for a given race from the search results for viewing as required by claims 20 and 49 of applicants' invention.

Accordingly, for at least these reasons, independent claims 20 and 49, and dependant claims 21-36 and 50-56, are allowable over claims 1-132 of Brenner in view of Faust.

VI. Reply to Claim Rejections  
Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-56 under 35 U.S.C. § 103(a) as being unpatentable over Wilson in view of Faust. The Examiner's rejections are respectfully traversed.

1. Claims 1-19 and 37-48

Wilson describes a video game system that simulates the horse racing experience. As described at column 1, lines 46-47, the Wilson system operates by "recreating what appears to be an actual horse race."

Although the Wilson system attempts to create a realistic simulation of an actual horse race, the Wilson system cannot be used to wager on actual races. The only races that a user of the Wilson patent may wager on have already been run. The races are pre-recorded video clips of actual past horse races. The game is preferably packaged as 1 or more CD-ROM discs for use with personal computers. (See column 1, line 39 - column 5, line 36 of Wilson).

Wilson merely allows a user to simulate wagering on races in a video game. Wilson fails to disclose or suggest providing a user with an option to record a race. Furthermore, there is no reason to record a race in Wilson because the races are pre-recorded races associated with the video game. The combination of Faust with Wilson, therefore, fails to provide any recording functionality to the video game. Moreover, a video game is non-analogous art to collecting and delivering multi-media application event data in an interactive network, thus there is no motivation to combine Faust with Wilson.

Accordingly, for at least these reasons, independent claims 1, 19, 37, and 48, and dependant claims 2-18 and 38-47, are allowable over Wilson in view of Faust.

## 2. Claims 20-36 and 49-56

The Examiner asserts that it would have been obvious to modify the interactive, off-track wagering system disclosed by Wilson to offer race videos using digital recordings stored in personal archives. The Examiner relies on Faust to suggest that such a system would provide an improved means for storing, managing, locating, and transferring of racing videos. Wilson, however, already discloses an archive of race videos. Pre-

recorded horse races are stored on 1 or more CD-ROM devices in a digital format. In a preferred embodiment, the races are stored on the hard disk of a user's computer to allow faster access time and transfer rates (see column 12, lines 14-19 of Wilson).

Wilson, however, fails to disclose or suggest a racing video archive that is remote from user equipment as specified in claims 20 and 49 of applicants' invention. Furthermore, Wilson teaches away from storing races remote from user equipment because the access time would be decreased. Moreover, neither Wilson nor Faust disclose or suggest using an interactive wagering application to search for racing videos in a racing video archive as required by claims 20 and 49 of the present invention.

Accordingly, for at least these reasons, independent claims 20 and 49, and dependant claims 21-36 and 50-56, are allowable over Wilson in view of Faust.

#### VII. Conclusion

In view of the foregoing amendment and remarks, claims 1-56 are in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

  
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APPENDIX  
CLAIM AMENDMENT MARK-UPS

1. (Amended) A method for a user at user equipment to interactively wager on races with an interactive wagering application implemented using the user equipment, comprising:

allowing the user to create and place a wager for a given race by interacting with a plurality of wager creation options;

automatically providing the user with an option to record the given race while the user is interacting with the plurality of wager creation options; and

recording the given race.